



PATENT
7251/94662

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Applicants: MAIL et al.)
)
For: OPTIMALLY ADAPTING)
MULTIMEDIA CONTENT)
FOR MOBILE SUBSCRIBER))
DEVICE PLAYBACK)
)
Serial No.: 10/589,417)
)
371(c) Date: 7 November 2006)
)
Group Art Unit: 2442)
)
Examiner: Michael W. Chao)
_____)

APPELLANTS' REPLY BRIEF ON APPEAL

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Dear Sir or Madam:

This is a Reply to the Examiner's Answer mailed 15 February 2011.

1. THE REFERENCES DO *NOT* SUGGEST WHAT IS CLAIMED

The claims recite that the claimed “stored multimedia content” is transcoded to be compatible with a first device, producing the claimed “firstly transcoded version.” They recite that an instruction (comprising the firstly transcoded version) is received to forward the content to a second device. They recite that, *in response to that instruction*, the original “stored multimedia content” (as opposed to the firstly transcoded version included with the instruction) is transcoded to be compatible with the second device.

Warsta discloses two embodiments. In its “pre-adaptation” mode, “content adaptations [are] provided for all known mobile terminal types and cached for later use.” (Warsta ¶61). As stated on lines 14-15 of page 21 of the Examiner’s Answer, since the final transcoding claim limitation “is stated to be in response to said instruction, it would... be after the ‘pre-adaptation’ of Warsta.” That is, the first Warsta embodiment does *not* suggest what is claimed.

The alternative Warsta embodiment discloses content adaptation when necessary rather than in advance. However, it does *not* suggest transcoding the original version rather than the received version. It does *not* suggest what is claimed.

The Examiner’s Answer asserted that it “would have been obvious to delay transcoding in order to prevent processing the media for device types that may never request the media.” (Ex. Ans. at lines 5-7 of p. 22). Sure, that is Warsta’s alternative embodiment. However, Warsta never suggests that it does not simply transcode whatever version is received, exactly what other prior art systems do in this scenario as quoted on page 9 of the appellants’ initial brief.

On page 23, the Examiner's Answer asserted that Warsta does not disclose a mechanism for deciding which version to transcode. That is true, because Warsta does not suggest what is recited in the claims. Warsta never suggests transcoding any version other than the one received, exactly like other prior art systems.

Malik adds nothing to Warsta in this regard. As stated on line 8 of page 20 of the Examiner's Answer, "Malik does *not* disclose transcoding...." [emphasis added].

A claim is not shown to be obvious by a combination of references when one of the claim limitations is not disclosed by any of those references. *See e.g. Honeywell International Inc. v. United States*, 596 F.3d 800, 810, 93 USPQ2d 1740, 1747 (Fed. Cir. 2010). In the captioned application, *none* of the references discloses or suggests transcoding the original version of the content (the "stored multimedia content") rather than the previously transcoded version (the "firstly transcoded version") that was included with the instruction to forward the content to the second device. Therefore, the combination of references does *not* render the claims obvious.

2. THE ALTERNATIVE CLAIM INTERPRETATION IS *NOT* REASONABLE

In the alternative, the Examiner's Answer erroneously argued on page 23 that the claims could be interpreted to mean that the claimed transcoding of the *stored multimedia content* (in response to the instruction to forward the content) could read on transcoding the *firstly transcoded version* (included in the instruction).

First, this claim interpretation *cannot* be correct, because it ignores that "stored multimedia content" and "firstly transcoded version" are expressly defined in the claims. To obliterate the distinctions between them is to rewrite the claims.

Second, this claim interpretation *cannot* be correct because it is inconsistent with the specification. For example, where instructions are received to forward content previously provided to mobile subscriber A and where the instructions include a copy of the transcoded content previously provided to mobile subscriber A (10:26-29), “the original content is retrieved and transcoded as necessary for playback on the multimedia device of mobile subscriber B.” (11:11-12). The point was *not* to transcode the version received from subscriber A which, as quoted in the appellants’ initial brief, was described in the Background section of the application as what prior art systems do. Even though the PTO gives claims their broadest reasonable construction, the Federal Circuit “has instructed that any such construction be ‘consistent with the specification....’” *In re Suitco Surface Inc.*, 603 F.3d 1255, 1260, 94 USPQ2d 1640, 1644 (Fed. Cir. 2010) (citations omitted).

The alternative claim interpretation expressed at the end of the Examiner’s Answer is *not* reasonable in view of the specification and in view of the express language in the claims.


3. CONCLUSION

For the foregoing reasons and those discussed in the appellants’ initial brief, favorable consideration of this Appeal and allowance of the application are respectfully requested.

Respectfully submitted,

11 April 2011

HUSCH BLACKWELL LLP
120 South Riverside Plaza, Suite 2200
Chicago, Illinois 60606
(312) 655-1500



L. Friedman
Reg. No. 37,135